UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,545	06/27/2001	Dominique Chantrain	Q64735	1856

7590   05/06/2005

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EXAMINER
KLINGER, SCOTT M

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/891,545	CHANTRAIN ET AL.
	Examiner	Art Unit	
	Scott M. Klinger	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 20050429

DETAILED ACTION

Claims 1-12 are pending.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter (i.e. the feature of the NAS communicating with a user device, not connected to the host VPN using logical channel referring to an identifier of the host VPN to which the user is currently connected), which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poisson et al. (U.S. Patent Number 6,765,591, hereinafter "Poisson") in view of Provino (U.S. Patent Number 6,557,037, hereinafter "Provino").

In referring to claims 1, 8, and 9-12, Poisson shows substantial features of the claimed invention, including a user registered in a Network Access Server as already connected to a Virtual Private Network (VPN): Poisson, Figs. 1 and 2 show users connected to a VPN.

However, Poisson does not show connecting to a device outside of the VPN through a logical channel. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Poisson as evidenced by Provino.

In analogous art, Provino discloses a system and method for easing communications between devices connected respectively to public networks such as the Internet and to private networks by facilitating resolution of human-readable addresses. Provino shows sending messages belonging to a communication between a user and a communication device over a logical channel between a Network Access Server and said communication device: *"Establishment of a secure tunnel can be initiated by device 12(m) external to the virtual private network 15 ... If the device 12(m) is authorized to access a server 31(s) in the virtual private network 15, the client 12(m) and firewall 30 engage in a dialog, comprising one or more message packets transferred therebetween over the Internet 14."* (Provino, col. 9, lines 46-60)

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Poisson so as to send messages belonging to a communication between said user and a communication device over a logical channel, such as taught by Provino, in order *"to access other devices outside of the virtual private network"* (Provino, col. 9, lines 8-9) and limit access to the VPN *"in a controlled manner"* (Provino, col. 9, line 13).

In referring to claim 2, Poisson in view of Provino shows,

- Detecting at said Network Access Server a message from said user destined to said communication device; and forwarding said message from said Network Access Server

to said communication device over the logical channel referring to the identifier of said Virtual Private Network:

"The virtual private network has a firewall, at least one internal device and a nameserver each having a network address. The internal device also has a secondary address, and the nameserver is configured to provide an association between the secondary address and the network address. The firewall, in response to a request from the external device to establish a connection therebetween, provides the external device with the network address of the nameserver." (Provino, col. 3, lines 1-9)

In referring to claim 3, Poisson in view of Provino shows,

- Detecting a message from said communication device being received at said Network Access Server on the logical channel referring to the identifier of a Virtual Private Network, said message containing a user destination address; determining a user registered in said Network Access Server as already connected to said Virtual Private Network and corresponding to said destination address; and forwarding said message from said Network Access Server to said user:

The external device, in response to a request from an operator or the like, including the internal device's secondary address, requesting access to the internal device, generates a network address request message for transmission over the connection to the firewall requesting resolution of the network address associated with the secondary address. The firewall provides the address resolution request to the nameserver, and the nameserver provides the network address associated with the secondary address to the firewall. The firewall, in turn, provides the network address in a network address response message for transmission over the connection to the external device. The external device can thereafter use the network address so provided in subsequent communications with the firewall intended for the internal device." (Provino, col. 3, lines 9-23)

In referring to claim 4, Poisson in view of Provino shows,

- Said messages belonging to the communication between said user and said communication device are encapsulated in data packets, said data packets comprising a field containing said identifier of said host Virtual Private Network or an indication derived of said identifier.

    "The device 12(m) can store in its IP parameter store 25 information concerning the secure tunnel, including information associating the identification of the firewall 30 and the identifications of the encryption and decryption algorithms and associated keys for message packets to be transferred over the secure tunnel." (Provino, col. 10, lines 7-12)

In referring to claim 5, Poisson in view of Provino shows,

- Said messages belonging to the communication between said user and said communication device are sent over a tunnel having said identifier of said host Virtual Private Network as tunnel identifier:

    Provino, col. 10, lines 7-12 (see full quote above)

In referring to claim 6, Poisson in view of Provino shows,

- Said messages contain IP packets comprising an IP address of said user:

    "The message packets transferred over the Internet 14 conform to that defined by the so-called Internet protocol "IP" and include a header portion, a data portion, and may include a error detection and/or correction portion." (Provino, col. 3, lines 62-66)

In referring to claim 7, Poisson in view of Provino shows substantial features of the claimed invention, including the system of claim 1 (see 103 rejection above). However, Poisson in view of Provino does not explicitly show that the external communication device belongs to a separate VPN. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Poisson in view of Provino.

A person of ordinary skill in the art would have readily recognized the desirability and advantages of implementing the system of Poisson in view of Provino so as to connect to an external device belonging to another VPN, in order *"to access other devices outside of the virtual private network"* (Provino, col. 9, lines 8-9) and limit access to the VPN *"in a controlled manner"* (Provino, col. 9, line 13).
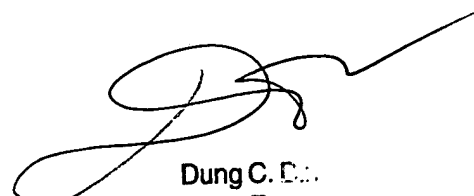
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Klinger whose telephone number is (571) 272-3955. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott M. Klinger
Examiner
Art Unit 2153

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